02-02-05

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Attorney Docket No. NEX87/PCT-US
Express Mail Label No. EV 586167595 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	PAGRATIS ET AL		
SERIAL NO.:	10/030,787	EXAMINER:	FORMAN, B.J.
FILED:	JANUARY 31, 2002	ART UNIT:	1634
TITLE:	HIGH AFFINITY TGFß NUCLEIC ACID LIGANDS AND INHIBITORS		

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Commissioner for Patents
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DECLARATION AND TERMINAL DISCLAIMER SUBMITTED UNDER 37 C.F.R. § 1.116;AND NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

NOTICE OF APPEAL

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision dated December 7, 2004, of the Examiner finally rejecting claims 2-7.

DECLARATION AND TERMINAL DISCLAIMER SUBMITTED UNDER 37 C.F.R. § 1.116

In order to expedite the resolution of this application by reducing the number of issues for consideration on appeal, a signed declaration by co-inventor Pagratis in accordance with 37 C.F.R. § 1.132 and terminal disclaimers in respect of U.S. Pat. Nos. 6,713,616 and 6,346,611 are hereby submitted under 37 C.F.R. § 1.116.

Remarks/Arguments begin on page 2 of this paper.

REMARKS AND ARGUMENTS

In the final Office Action of December 7, 2004, claims 2-7 were rejected as being anticipated under 35 U.S.C. § 102(e) by Gold et al., U.S. Patent No. 6,124,449. Claims 2-7 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable: over claims 2-14 of U.S. Pat. No. 6,713,616; over claims 1-5 of U.S. Pat. No. 6,346,611; and over claims 1-11 of U.S. Pat. No. 5,731,424 in view of Gold et al U.S. Pat. No. 6,124,449. Claims 2-7 were also rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The present submission under 37 C.F.R. § 1.116 is intended to reduce the number of issues for consideration on appeal.

Applicants gratefully acknowledge the withdrawal of the 35 U.S.C. § 112, first paragraph rejection of claims 2-7 for lack of enablement. Applicants also gratefully acknowledge the withdrawal of the rejection of claims 2-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Pat. No. 6,124,449.

The Rejection under 35 U.S.C. § 102(e)

In the final Office Action of December 7, 2004, claims 2-7 were rejected as being anticipated under 35 U.S.C. § 102(e) by Gold et al., U.S. Patent No. 6,124,449. The Examiner notes that in an earlier response dated September 20, 2004, Applicants submitted declarations under 37 C.F.R. § 1.132 showing that the invention disclosed but not claimed in Gold et al. was derived from co-inventors Gold and Pagratis of the instant application, but that as the declarations were submitted unsigned the rejection was maintained. In a supplemental response expressed mailed on November 24, 2004, the signed declaration of co-inventor Gold was submitted. Applicants now submit the signed declaration of co-inventor Pagratis under 37 C.F.R. § 1.116. In view of submission of signed declarations from co-inventors Gold and Pagratis, withdrawal of the 35 U.S.C. § 102(e) rejection of claims 2-7 is respectfully requested.

The Double Patenting Rejections

U.S. Patent No. 6,713,616 and U.S. Patent No. 6,346,611

Claims 2-7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-14 of U.S. Patent No. 6,713,616, and also over claims 1-5 of U.S. Patent No. 6,346,611. While not acquiescing in these rejections, Applicants hereby submit terminal disclaimers. It is believed that that the terminal disclaimers are sufficient to overcome the double-patenting rejections.

U.S. Patent No. 5,731,424 in view of U.S. Patent No. 6,124,449

Claims 2-7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,731,424 in view of U.S. Patent No. 6,124,449. With reference to the section above entitled "The Rejection under 35 U.S.C. § 102(e)," the signed 37 C.F.R. § 1.132 declarations of co-inventors Gold and Pagratis indicate that U.S. Patent No. 6,124,449 is not available as a prior art reference with which to evaluate whether the pending claims of the instant application are a mere obvious variation of claims 1-11 of U.S. Patent No. 5,731,424. Withdrawal of the obviousness-type double patenting rejection is respectfully requested.

Closing Remarks

This submission under 37 C.F.R. § 1.116 is intended to reduce the number of issues remaining for consideration on appeal. Specifically, after entry of this submission, the only issue remaining of appeal is the 35 U.S.C. § 112, first paragraph rejection of claims 2-7 as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Fees

The notice of appeal fee is $500 (37 C.F.R § 41.20(b)(1).

The fee for the submission of two terminal disclaimers is $260 (37 C.F.R. § 1.20(d).

A check in the amount of $760 is enclosed.

If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

Date: January 31, 2005

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